

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ALEXANDER SLOOT

Appeal No. 2004-1917
Application No. 09/853,096

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11. Claims 12 to 14, which are all of the other claims pending in this application, have been withdrawn from consideration.

We AFFIRM.

BACKGROUND

The appellant's invention relates to self-wrapping decorative articles, and more particularly to self-wrapping decorative articles for toys, safety toys and devices, and for wrapping to legs, arms, posts, columns, cords or other similar structures, and methods for manufacturing self-wrapping decorative articles. Particularly, the appellant's invention relates to self-wrapping decorative articles made from materials, which are capable of retroreflecting light, and having a protective layer, which prevents retro-reflective capabilities of the materials from rapid deterioration as a result of extensive use (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Richards	2,502,535	Apr. 4, 1950
Anello	3,410,023	Nov. 12, 1968
Kuroda	3,730,814	May 1, 1973
Nestegard et al. (Nestegard)	5,962,108	Oct. 5, 1999

Claims 1 to 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anello in view of Richards or Nestegard and further in view of Kuroda.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 4, mailed October 21, 2002) and the answer (Paper No. 7, mailed May 22, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 6, filed November 25, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the

invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir.

1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein).

With this as background, we turn to the rejection of claim 1 under 35 U.S.C. § 103.

Claim 1 reads as follows:

A self-wrapping decorative article comprising:
at least one an elongate generally flat wrapping member having ends and elongate side edges and surfaces extending between the ends, the flat wrapping member being formed of a type such that the ends are capable of coming together and remaining extended;
a first decoratively shaped retroreflective layer located over one surface of said one elongate wrapping member, said first decoratively shaped layer having a lateral dimension that is substantially greater than the lateral dimension of said wrapping member, so that said first decoratively shaped layer extends with a decoratively shaped portion past at least one of said edges;
a second layer overlying another surface of said wrapping member opposite to said one surface; and
said first and second layers being affixed to each other so as to encase said elongate wrapping member and form a decoratively shaped retroreflective article capable of self wrapping around an object.

Anello's invention deals with a novelty or toy item, of roll spring tape material such as heretofore been used for steel measuring tapes, with added ornamental

material characteristic of toys. Anello's novelty or toy item includes a length of roll spring tape with ornamental preferably soft material affixed to one end to simulate an animal head, and related toy-simulating material affixed at the other end to simulate an animal tail or other remote body portion, and if desired, other material covering the tape between its two ends whereby to simulate an animal body. The novelty or toy item may be straightened and will hold itself straight (with the spring tape concave), the desired action results when the tail portion and body portion are permitted to coil on themselves, with the end to which the head-simulating material is affixed either rearing itself more or less erect or coiling around the body portion.

Anello teaches (column 3, lines 2-8) that:

other forms than those of toy animals may be utilized; materials other than fluffed materials may be used for covering the tape 10; the tape 10 may be covered on both of its sides, as by encasing in an ornamental plastic soft flexible body; and varying ornamental designs may be applied or incorporated depending on the artistic ideas of the manufacturer.

Anello further teaches (column 2, lines 32-48) that if the user desires, the novelty or toy item can be coiled around the user's wrist so as to be a novel bracelet.

Richards' invention relates to a reflector which is to be worn on the arm of a pedestrian or cyclist as a warning to motorists after dark; and has for an object to provide a light weight, small, convenient arm band which maybe worn on the arm of

persons when walking on or, near the highway at night and has light reflecting means which may be readily seen at a considerable distance, so that the driver of an approaching automobile will be warned of their presence. The reflecting means comprises a strip composed of paper or other similar flexible backing material on which is cemented a surface layer of very small glass beads held by cellulose or similar waterproof cement.

Nestegard's invention provides a useful retroreflective flexible fabric material adaptable for use in numerous applications, for example, but not limited to, use by humans in articles of clothing for safety or fashion or accessories such as a personal bag or back pack, use for articles for pets and other animals, as well as articles for use on signs and machinery such as road signs, roll up signs, flexible vehicle covers, tarpaulins, warning tapes, and conspicuity markings. Nestegard's invention provides a high brightness, flexible, durable, retroreflective sheeting compatible for attachment to polymer coated flexible fabric material comprising a polymeric prismatic retroreflective layer having a high coefficient of retroreflectivity and a polymeric compatibilizing layer for attachment to a flexible polymeric coated fabric material. Nestegard teaches (column 1, lines 18-20) that retroreflective conspicuity devices have been developed for use to increase safety and visibility especially during periods of reduced visibility.

Kuroda's invention relates to a die for making a beaded article having a support layer on which a bottom layer and a top layer of sheet material are superimposed. The top layer is heat bonded to the bottom layer and both are heat bonded to the support layer along a circumferentially complete narrow annular zone. In the area circumscribed by the annular zone the top layer is provided with a raised self-supporting bead-like prominence which contains ornamental particles visible to a viewer because the top layer is of transparent material. The die has a base portion from which extend projections whose free end faces are formed with recesses which are bounded by annular cutting edges located in the plane of the respective endface, and by a bevelled shoulder which is inwardly inclined away from the associated cutting edge.¹

The appellant argues (brief, pp. 4-9) that (1) Anello does not teach or suggest that one of the layers be retroreflective; and (2) that neither Richards nor Nestegard provide the required motivation for a person of ordinary skill in the art to have modified one of the layers of Anello's toy to be retroreflective.

¹ Kuroda was not utilized by the examiner in determining the obviousness of the subject matter of claim 1.

In our view, there is sufficient motivation for a person of ordinary skill in the art at the time the invention was made to have modified one of the layers of Anello's novelty or toy item to be retroreflective for the reasons which follow.

There is no rule of law that an express, written motivation to combine references must appear in the applied prior art before a finding of obviousness. The Federal Circuit has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved. See Pro-Mold v. Great Lakes Plastics, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); In re Huang, 100 F.3d 135, 139 n.5, 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996). The Federal Circuit has stated that "[t]his form of motivation to combine evidence is particularly relevant with simpler mechanical technologies." Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1691 (Fed. Cir. 2004).

Richards teaches providing reflecting means on an arm band so that a pedestrian or cyclist may be readily seen at night at a considerable distance by the driver of an approaching automobile. Nestegard teaches that retroreflective conspicuity devices on articles of clothing or accessories have been developed for use to increase safety and visibility. Thus, both Richards and Nestegard teach that the nature of the

problem to be solved is enhancing safety by providing a retroreflective layer to an article to be worn by a person to increase visibility.

Anello's novelty or toy item is not limited to being just a toy intended to be played with indoors. Anello specifically teaches that his novelty or toy item can be coiled around the user's wrist so as to be a novel bracelet. As a bracelet, Anello's novelty or toy item is an article intended to be worn by a person. As such, it is our conclusion that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Anello's novelty or toy item by providing a retroreflective layer thereto to increase visibility as suggested and taught by either Richards or Nestegard. The motivation for this change coming from the nature of the problem to be solved and the teachings of the applied prior art, not from hindsight knowledge derived from the appellant's own disclosure.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

The decision of the examiner to reject claims 2 to 11 under 35 U.S.C. § 103 is also affirmed since the appellant has not argued separately the patentability of any particular claim apart from the others, thus allowing claims 2 to 11 to fall with claim 1

(see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv)).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2004-1917
Application No. 09/853,096

Page 13

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